

### REMARKS

This preliminary amendment accompanies a Request for Continued Examination (RCE).

Applicant kindly appreciates the telephone interview with the Examiner and the Examiner's supervisor on 21 February 2007 to discuss proposed amendments. No agreement was reached. The preliminary amendments further clarify the claimed subject matter.

Claims 6, 17, 23, 29 and 40-71 are pending in this application. Applicant has amended claims 6, 7, 23 and 29. New claims 52 to 71 have been added. Support for the amendments to the claims is provided in the Specification at p. 19-22, for example. Accordingly, no new matter has been introduced.

Claims 6, 7, 23, 29, 40-41, 44-46 and 48-50 have been rejected under 35 U.S.C. 103(a) as unpatentable over the Foladare et al. patent (US 6,311,210 B1) in view of the Redpath patent (US 6,256,672 B1), and claims 42, 47 and 51 have been rejected as unpatentable over these references further in view of the Ulrich et al. patent (US 6,052,735). Applicant respectfully traverses these rejections in view of the above amendments and the following remarks.

Amended claim 6 recites an article with a machine-readable medium storing machine-readable instruction. A sender is enabled to append an attachment to a message and to designate at least one recipient to receive the message and the attachment, and to designate at least one recipient to receive the message without the attachment. A recipient is enabled to create and edit a reception profile, which includes the recipient's preferences with regard to receipt of prospective attachments. The message is transmitted over a network from the sender to the recipients. However, the message is transmitted from the sender without the attachment to any recipient whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment.

Thus, the reception profile prevents transmitting an attachment to a recipient who has specified not to receive an attachment. The amendment clarifies that the reception profile

influences the transmission process, *i.e.*, whether an email will be sent with or without the attachment.

The Foladare et al. patent discloses a centralized electronic mail apparatus that delivers a previously transmitted email to a receiving party (col. 1, ll. 36-55):

When a sending party wishes to send an electronic mail message to a receiving party, the sending party creates the electronic mail message along with any attachments using his/her user device and sends the electronic mail message to the centralized electronic mail apparatus. The centralized electronic mail apparatus receives the electronic mail message and retrieves profile information from a profile database corresponding to the receiving party. Based on the profile information, the centralized electronic mail device further determines the receiving party's electronic mail receiving devices to which the electronic mail message is to be sent. The centralized electronic mail apparatus further determines the portions of the electronic mail message that are to be sent to each of the electronic mail receiving devices.

The centralized electronic mail apparatus then sends the portions of the electronic mail message to the electronic mail receiving devices and monitors them to determine if the receiving party has retrieved the electronic mail message from any of the electronic mail receiving devices.

The centralized electronic mail apparatus is involved in the distribution process of an email message that already was sent from a sending party. On the receiver's side, a profile database is used in a way that, for example, "only those portions of the electronic mail message, which the receiving party deems the most important by identifying them in the profile database 165, are sent to the electronic mail receiving device 120-150." (col. 6, ll. 11-15)

However, this distribution process on the recipient's side does not affect whether the email message on the sender's side is sent with or without the attachment.

Therefore, the Foladare et al. patent does not disclose that a reception profile created by a recipient affects the sending of an email with or without attachments, *i.e.*, that "the message is transmitted from the sender without the attachment to any recipients whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment."

The Redpath patent discloses a new addressee line identifier that allows an e-mail sender to notify additional addressees of what has been sent to the primary addressee without slowing down transmission time or wasting storage space by including unneeded and possibly quite large attachment files (abstract). Here, the sender himself determines the sending process.

The Redpath patent also does not disclose a reception profile that affects the sending of an email message on the sender's side.

The Ulrich et al. patent refers to the synchronization between a desktop computer and a mobile device. Both, the desktop computer and the mobile device, are used by the recipient. Therefore, the synchronization takes place at the recipient's side. The synchronization has no affect on the transmission of an email message from the sending party.

The cited references disclose systems that act only on the sender's or the recipient's side. The Redpath patent acts on the sender's side; the Foladare et al. patent as well as the Ulrich et al. patent act on the recipient's side. None of the references suggests or motivates that a reception profile created by a recipient impacts whether the message is transmitted from the sender with or without an attachment.

In view of the forgoing comments and the claim amendments, Applicant respectfully requests that the Examiner withdraws the rejection of claim 6.

At least for the foregoing reasons, claim 6 and its dependent claims should be allowed. Claims 17, 23 and 29 recite similar features. Those claims, as well as its dependent claims, also should be allowed for the same reasons.

New claims 52-71 have been added. New independent claims 52, 57, 62 and 67 recite that "even though the sender designated that recipient to receive the message with the attachment," the message is transmitted from the sender without the attachment if the recipient's reception profile specifies so. As discussed above, this interaction between recipient's and sender's side is new and non-obvious with regard to the cited references.

#### Conclusion

Applicant asks that all claims be examined in view of the amendment to the claims.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the foregoing remarks, all pending claims are believed to be allowable and a notice of allowance is requested.

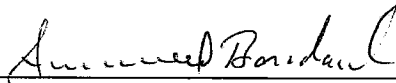
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This preliminary response is being filed with a Request for Continued Examination. The fees for the Request of \$790.00 and for the Three Month Extension of Time of \$1020.00 are being filed concurrently with the Electronic Filing System (EFS) by way of Deposit Account authorization. Please charge all charges or credits to deposit account 06 1050, referencing Attorney Docket No. 21175-002001.

Respectfully submitted,

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